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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,812	04/13/2001	Shuichi Kikuchi	450100-03161	8677

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EXAMINER

MILLER, BRIAN E

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 04/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/834,812

Applicant(s)

KIKUCHI, SHUICHI

Examiner

Brian E. Miller

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Amendment "A" (filed 3/13/03).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-10 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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Claims 1-10, 15 are now pending.

***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-10, 15, in Paper No. 6 is acknowledged.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 7, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeda et al (US 5,308,708). Takeda et al discloses a stainless steel metal shutter (FIG. 5) for a disc cartridge which includes a plastic enclosure and disc medium (col. 1, lines 13-22), further including: a screen portion having inside and outside surfaces B, C (FIG. 5) having an indication area on the outside surface B, the indication area including a rough surface portion, i.e., having a surface roughness, and an inside surface thereof C, having another rough surface area (see col. 4, lines 17-25 and 44-58); wherein the shutter has a thickness between 0.15 mm and .5 mm, i.e., 0.2 mm (see col. 8, line 54) (re claim 2); wherein the shutter is formed from stainless steel (col. 4, line 3) (re claim 3); wherein the roughness of the inside surface is less than the roughness of the outside surface (see Table 2); wherein the indication area B is provided on a flat portion of the screen portion.

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda et al in view of Kikuchi (US 5,729,272). Although Takeda et al suggests printing” can be configured on the shutter (see col. 2, lines 15-20) is silent as to any details thereof. Kikuchi, however, discloses specific details on how to provide characters, pictures, etc. on a metal shutter surface (see col. 1, lines 42-55). As shown in FIGs. 1-5, shutter 5 is provided with a heat transfer film 10 which is inherently smoother than the roughness of the shutter. From this teaching, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a heat transfer film onto the plain shutter of Takeda et al. The motivation would have been: providing such a film on a shutter would have colorfully displayed contents, pictures, printing, etc. on the shutter, while increasing accuracy and reducing process steps, which advantages would have been readily realized by a skilled artisan.

***Allowable Subject Matter***

5. Claims 8-10 are allowable over the prior art. Reasons for allowance will be set forth upon allowance of the application.

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***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure including US Patents to Fujita (5,151,894) and Funayama et al (5,161,080) which are cited to show shutters with inside or outside surface roughness areas, however, the shutters are formed of plastic.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Miller whose telephone number is (703) 308-2850. The examiner can normally be reached on M-F 7:45am-5:15pm (FF off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.



**Brian E. Miller**  
**Primary Examiner**  
**Art Unit 2652**

bem  
April 3, 2003